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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,566	06/26/2001	Pascal Bazin	B-0707	9406
24628	7590	08/22/2005	EXAMINER	
WELSH & KATZ, LTD 120 S RIVERSIDE PLAZA 22ND FLOOR CHICAGO, IL 60606			LAYE, JADE O	
			ART UNIT	PAPER NUMBER
			2617	

DATE MAILED: 08/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/888,566

Applicant(s)

BAZIN ET AL.

Examiner

Jade O. Laye

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☒ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 30/03
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 10/30/03 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner.

Specification

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 11-13, 18-25, and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding Claims 11-13, the phrase "...and others still" renders the claim indefinite. As such, appropriate correction is required.

Regarding Claims 18-25, the phrase "such as" renders the Claim 18 (and all claims dependent on Claim 18) indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Regarding Claim 30, the Examiner considers the phrase "like a XML compiler" to be equivalent to "*such as* an XML compiler." According to Office Practice and Procedures, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Moreover, it is unclear whether Applicant intends the phrase "... (StreamCast®, OpenTV®, MediaHighway®)..." to limit Claim 30 or whether Applicant only intended the phrase to define an exemplary platform. Accordingly, this phrase further limits Claim 30 indefinite and appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4, 6-13, 18-27, and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by *Hendricks et al.* (WO 94/13107).

As to Claim 1, *Hendricks et al* disclose a digital television network comprising a data storage means, means for transmitting digital applications, broadcasting means (i.e., agencies centre), transcoder means, and a plurality of set top boxes ("STB"). (Abstract; Pg. 10, Ln. 30-Pg. 11, Ln. 21; Pg. 13, Ln. 25-28; Pg. 18, Ln. 11-16). Accordingly, *Hendricks et al* anticipate each and every limitation of Claim 1.

As to Claim 2, *Hendricks* further teaches the system comprises a means for editing, indexing, and distributing said digital applications, an interactive user interface, and a predefinable navigation menu. (Pg. 7, Ln. 10-12; Pg. 13, Ln. 14-Pg. 14, Ln. 30; PG. 24, Ln. 21-32; PG. 38, Ln. 10-22; Pg. 39, Ln. 24-Pg. 40, Ln. 17). Accordingly, *Hendricks et al* anticipate each and every limitation of Claim 2.

As to Claim 3, *Hendricks* further discloses the system comprises a menu, hierarchical list, properties zone (i.e., any associated data), and a contents display zone. (Figs. 19b-23 and all cited portions used under rejection of Claim 2). Accordingly, *Hendricks et al* anticipate each and every limitation of Claim 3.

As to Claim 4, *Hendricks* further teaches the system comprises a zone for elements to be selected and a zone for editing the values (i.e., any associated data) of the selected content. (Fig. 16A; Pg. 14, Ln. 8-29). *Hendricks* goes on to discuss that the names of movies change on a regular basis. Such changes are sent downstream and, therefore, it is inherent the cable operator be allowed to edit names of the elements (i.e., movies, etc.). (Pg. 39, Ln. 24-Pg. 40, Ln. 4). Accordingly, *Hendricks et al* anticipate each and every limitation of Claim 4.

As to Claim 6, *Hendricks* further discloses the system is capable of transmitting certain data to specified STBs. (Pg. 14, Ln. 30-Pg. 15, Ln. 8; Pg. 18, Ln. 20-Pg. 19, Ln. 7). Thus, it is

inherent the system have some way of determining which STB receives which programming or, i.e. an access rights manager. Accordingly, *Hendricks et al* anticipate each and every limitation of Claim 6.

As to Claim 7, the Office considers claims containing the phrase “one at least of” to be anticipated when at least one of the subsequent elements are found in the prior art. Accordingly, *Hendricks* further teaches the system allows a user to edit certain data (i.e., edit function). (disclosed in previous rejections). Thus, *Hendricks et al* anticipate each and every limitation of Claim 7.

As to Claim 8, *Hendricks* further teaches the system allows a user to edit (i.e., Rename/Modify) certain data. (refer to Claim 4’s rejection). Accordingly, *Hendricks et al* anticipate each and every limitation of Claim 8.

As to Claims 9 and 10, it is apparent that *Hendricks’* system comprises a means for “processing” and “displaying” video, respectively. (all cited portions). Accordingly, *Hendricks et al* anticipate each and every limitation of Claim 9.

As to Claims 11 and 12, it is apparent from the previous citations that *Hendricks’s* system is capable of displaying audiovisual data and also provides an electronic programming guide (i.e., catalogue), respectively. Accordingly, *Hendricks et al* anticipate each and every limitation of Claims 11 and 12.

As to Claim 13, it is also clear from the previous citations that *Hendricks’* system is capable of processing video, sound, and pictures. Accordingly, *Hendricks et al* anticipate each and every limitation of Claim 13.

As to Claim 18, *Hendricks* further discloses the system is capable of processing TV objects, screens, and other data applications. (previous citations). Moreover, the system is also capable of tracking user channel access (i.e., identify channels on customer stations). (Pg. 18, Ln. 20-Pg. 19, Ln. 8). Accordingly, *Hendricks et al* anticipate each and every limitation of Claim 18.

As to Claim 27, *Hendricks* further discloses the system is capable of transmitting data detailing the program category (i.e., type). (Pg. 14, Ln. 8-Pg. 15, Ln. 8). Accordingly, *Hendricks et al* anticipate each and every limitation of Claim 27.

As to Claim 28, *Hendricks'* system is clearly compatible with any STB connected to the system. (all disclosed citations). Accordingly, *Hendricks et al* anticipate each and every limitation of Claim 28.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 14-17 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Hendricks et al.*

As to Claims 14 and 15, *Hendricks* only discloses the use of one broadcasting center (i.e., agencies centre) and transcoder and fails to specifically disclose the limitations recited in Claim 14. However, the use multiple broadcasters and transcoders within multiple components would have been an obvious design choice. Accordingly, it would have been obvious to one having ordinary skill in this art at the time of Applicant's invention to modify the system of *Hendricks* in order to provide a system which can support a broader subscriber base.

As to Claim 16, it would be inherent the components in *Hendricks'* system cooperate with the other components in efforts to manage the data and broadcast streams. Accordingly, the modified system of *Hendricks et al* contain each and every limitation of Claim 16.

As to Claim 17, *Hendricks* further disclose the system comprises a system distribution server, which is connected to each STB via a bidirectional link. (Figs. 1 & 3). Accordingly, the modified system of *Hendricks et al* contain each and every limitation of Claim 17.

Claim 31 contains limitations which are disclosed in Claims 6 and 17. Therefore, the modified system of *Hendricks et al* contain each and every limitation of Claim 31.

6. Claims 5, 19-26 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Hendricks et al* in view of *Sezan et al.* (US Pat. No. 6,236,395).

Claim 5 recites the network of Claim 3, characterized in that the content display zone comprises control means for selecting a mode of display in Table form, in Zoom form, in Caption form, and in single or multiple selection mode. As to Claim 5, *Hendricks* further teaches the use of a display zone in Table form, but fails to disclose the remainder of the limitations recited in Claim 5. (Fig. 16a). However, within the same field of endeavor, *Sezan et al* disclose a similar system wherein a user is allowed to search and filter (i.e., select) programs which can be viewed in zoom form (i.e., close-up view), caption form, and single or multiple selection mode (i.e., system can operate in both high and low level modes). (Col. 4, Ln. 40-Col. 5, Ln. 32; Col. 8, Ln. 30-55; Col. 13, Ln. 33-45). Accordingly, it would have been obvious to one of ordinary skill in this art at the time of Applicant's invention to combine the systems of *Hendricks* and *Sezan*, thereby providing a more efficient and user friendly system via the use of scene indexing and searching capabilities.

Claim 19 recites the Network of Claim 18, further comprising limitations too numerous to recite herein. (refer to Claim sheet). As discussed above, *Hendricks* anticipates each and

every limitation of Claim 18, and further discloses the system is capable of processing an application name/ID (discussed in Claim 4) and access rights (also discussed under Claim 4), but fails to specifically disclose the remainder of the limitations in Claim 19. However, within the same field of endeavor, *Sezan* discloses a similar system which processes lists of TV scenes and color profiles. (Col. 4, Ln. 40-Col. 5, Ln. 8; Fig. 7-12). Accordingly, the combined systems of *Hendricks* and *Sezan* contain all limitations of Claim 5.

Claim 20 recites the Network of Claim 19, further comprising limitations too numerous to recite herein. (refer to Claim sheet). As discussed above, *Hendricks* anticipates each and every limitation of Claim 19, and clearly discloses the system is capable of processing a list of TV objects, but fails to specifically disclose the remainder of the limitations in Claim 20. However, *Sezan* further discloses the use of timestamp information (i.e., duration of scenes) and scene names. (Col. 26, Ln. 58-62; Fig. 7). Accordingly, the combined systems of *Hendricks* and *Sezan* contain all limitations of Claim 20.

As to Claim 21, it is unclear what Applicant intends by the term “multipage scene.” Therefore, for the purposes of this rejection, the Examiner interprets this term to refer to a page which contains multiple scenes as disclosed on Figures 4-7 of *Sezan*. The remainder of the limitations mirror those of Claim 20 and are analyzed and rejected accordingly. Therefore, the combined systems of *Hendricks* and *Sezan* contain all limitations of Claim 21.

As to Claim 22, *Hendricks* further teaches the use of a means for processing a list of “TV menu-lists.” Please note the Examiner is also confused as to what Applicant intends by this limitation. Therefore, the Examiner interprets this phrase to denote any menu list which is processed by the system. Thus, *Sezan*’s Figures 4-12 disclose the system is capable of

processing menu lists. The remainder of the limitations mirror those of Claim 20, and thus, are analyzed and rejected accordingly. Therefore, the combined systems of *Hendricks* and *Sezan* contain all limitations of Claim 22.

The limitations of Claim 23 are encompassed within the limitations of Claims 21. Thus, it is analyzed and rejected as discussed therein.

As to Claim 24, *Sezan* further discloses the use of categories (i.e., list names), TV headings (i.e., “title text”), and objects associated with said categories. (Col. 17, Ln. 65-Col. 14, Ln. 40; Figs. 4-12). Accordingly, the combined systems of *Hendricks* and *Sezan* contain all limitations of Claim 24.

Claim 25 is encompassed within the limitations/citations of Claim 24. Thus, it is analyzed and rejected as previously discussed.

As to Claim 26, *Sezan* further teaches the system is capable of providing close-up views of audiovisual data (i.e., manipulates picture objects). Accordingly, the combined systems of *Hendricks* and *Sezan* contain all limitations of Claim 26.

Claim 29 recites the network of Claim 2, further comprising limitations too numerous to recite herein. (refer to claim sheet). As discussed above, *Hendricks et al* anticipate each and every limitation of Claim 2, and further disclose the use of an interactive user interface. (refer to previous citations). But, *Hendricks et al* fail to disclose the remaining limitations. However, within the same field of endeavor, *Sezan et al* disclose a similar system which utilizes icons and various menu screens (i.e., pop up menus). (Figs. 4-12). Moreover, the Examiner takes Official Notice that, at the time of Applicant’s invention, it was notoriously well known in this art to utilize pop-up icons. (As evidenced by *Dunn et al*, US Pat. No. 5,517,257 at Col. 3, Ln. 14-16 &

36-40). Accordingly, the combined systems of *Hendricks* and *Sezan* contain all limitations of Claim 29.

7. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Hendricks et al* in view of *Wine*. (US Pat. No. 4,418,364).

As to Claim 30, *Hendricks* further teaches the use of a transcoder, which can provide a signal formatted in the same format as the STB. (Pg. 18, Ln. 11-16). This transcoder, in essence, is a “correcting” module, because it will reformat the signal into the correct format necessary for transmission. But, *Hendricks* fails to specifically disclose the use of a transcoder connected to a correcting input. However, within the same field of endeavor, *Wine* discloses a similar system which comprises a transcoder having a timebase error correction circuit. (Col. 3, Ln. 7-27). Accordingly, it would have been obvious to one having ordinary skill in this art at the time of Applicant’s invention to combine the systems of *Hendricks* and *Wine* in order to provide a system which allows for a more dependable transcoding process.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jade O. Laye whose telephone number is (571) 272-7303. The examiner can normally be reached on Mon. 7:30am-4, Tues. 7:30-2, W-Fri. 7:30-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2617

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner: Jade O. Laye
August 12, 2005.



NGOC-YEN VU
PRIMARY EXAMINER